REMARKS

Claims 1 to 55 are pending in the application.

Claims 1-7, 9, 26-51, 54, and 55 are canceled.

Claims 8, 10, 22, 25, 52, and 53 are currently amended.

Claims 11-14, 16, 18, 20, and 23 are original.

Claims 15, 17, 19, 21, and 24 are previously presented.

Claims 8, 10-25, 52, and 53 would be all of the claims pending in the application if the instant amendment is entered.

Discussion of claim amendments

Claim 8 is currently amended to incorporate subject matter that was previously incorporated by reference from claim 1, and now all of the remaining claims depend directly or indirectly from claim 8. Other claim amendments correct typographical errors or for readability purposes.

Applicants request entry of the amendment after final under 37 C.F.R. § 1.116 because the amendment cancels certain claims and puts claim 8 in better form for an appeal.

Claim Rejections - 35 U.S.C. § 103 – WO 99/01426

Claims 1-4, 9-25, 52, and 53 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 99/01426 ('426). Applicants traverse the rejection because claims 1-4 and 9 are canceled and claims 10-25, 52, and 53 now depend, directly or indirectly, from claim 8 instead of claim 1 and claim 8 is not part of this rejection

Claim Rejections - 35 U.S.C. § 103 – WO 99/01421

Claims 1-4, 6-25, 52, and 53 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 99/01421 ('421). It was stated in the non-final Office Action mailed February 23, 2005 ("Non-final Office Action"), that the '421 publication teaches 4-iodo-phenylamino benzamide compounds, including the elected species, as MEK inhibitors useful in treating diabetes, proliferative disorders such as cancer, and inflammation. Inflammation is mentioned in the Abstract. The Non-final Office Action noted that the '421 publication does not expressly teach the elected specie are useful for treating chronic pain. In the Final Office Action, it was alleged that it would have been obvious to one of ordinary skill in the art at the time the invention was made ("Skilled Artisan") to employ the elected specie in a method of treating chronic pain

because the Skilled Artisan would have been motivated to employ the elected specie in the instant method since cancer is always associated with chronic pain. It was mentioned in the Final Office Action that employing the elected specie in a method of treating cancer in cancer patients before or after surgical removal of the cancer and thereby providing chronic pain relief allegedly would be reasonably expected to be effective.

Applicants traverse the rejection because claims 1-4, 6, and 7 are canceled, rendering rejection of claims 1-4, 6, and 7 moot, and because they believe that the method of claim 8 and claims 9-25, 52, and 53, which depend from claim 8, is not obvious because:

> (1) there was no suggestion or motivation, either in the '421 reference itself or in the knowledge generally available to one of ordinary skill in the art, to selectively modify the '421 reference's teaching of a method of treating cancer to arrive at the instant method of treating chronic pain associated with arthritis;
>
> (2) there was no reasonable expectation of success using the compounds of the '421 reference in the instant treatment of chronic pain associated with arthritis; and
>
> (3) the '421 reference or knowledge of the Skilled Artisan did not teach or suggest the instant limitation of treating chronic pain associated with arthritis.

Applicants hereby incorporate by reference their remarks concerning this rejection that Applicants made in their paper titled "Amendment and Reply Under 37 C.F.R. § 1.111" transmitted April 15, 2005 ("Applicants' April 15, 2005, Paper").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. (MPEP § 2142)

Instant claims 8, 9-25, 52, and 53 relate to using the MEK inhibitors of the '421 reference in a method of treating chronic pain associated with arthritis. The '421

reference discloses that the instant MEK inhibitors are useful for treating cancer, stroke, and diabetes, among other diseases (page 7, lines 5-17), and inflammation (Abstract). The knowledge of the Skilled Artisan would have included the Food and Drug Administration (FDA) web page http://www.fda.gov/cder/cancer/druglistframe.htm and the links embedded therein, which list approved oncology drugs and their approved indications. Applicants believe that cancer pain is not currently recited as an approved indication in most of the entries for such drugs. The undersigned did a "Find (on this page)" search for the term "pain" on the web page. Out of a list of about 100 different oncology generic drugs, the undersigned only found mitoxantrone had an approved indication that recited pain, which related to advanced hormone-refractory prostate cancer. It is Applicants' belief that a similar finding would have been known to the Skilled Artisan.

(1) No suggestion or motivation to modify the '421 reference's cancer teaching:

Applicants believe that there was no suggestion or motivation, either in the '421 reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the '421 reference's teaching of using the instant compounds in a method of treating cancer to arrive at using the compounds in the instant method of treating chronic pain associated with arthritis because the Skilled Artisan was aware that oncology drugs produce side effects such as cytotoxicity, nausea, weight loss, and hair loss, and these side effects that would be unacceptable to arthritis patients and to the FDA for a treatment of chronic, non-life threatening conditions such as chronic pain associated with arthritis.

(2) No reasonable expectation of success:

Applicants believe that there would have been no reasonable expectation of success from modifying the '421 reference's teaching of using the instant compounds in a method of treating cancer to arrive at the instant treatment of chronic pain associated with arthritis because most oncology drugs were not approved by the FDA for use as analgesics.

(3) Not all claim limitations taught or suggested:

As the Non-final Office Action noted, the '421 reference does not expressly teach the elected specie are useful for treating chronic pain. Applicants believe that the '421 reference does not teach or suggest the limitation of using the elected specie for treating chronic pain associated with arthritis. In the Office Actions, it was stated that "cancer is

always associated with chronic pain." However, even if this universal association of cancer and chronic pain were true, which it is not as shown in Applicants' April 15, 2005, Paper, it was not established in the Office Actions that oncology drugs in general were known by the Skilled Artisan to be useful for treating chronic pain associated with arthritis.

Accordingly, Applicants believe that claims 8, 9-25, 52, and 53 are not obvious and are patentable under 35 U.S.C. § 103(a) in view of WO 99/01421.

Information Disclosure Statement

Applicants make available to the Patent and Trademark Office an Information Disclosure Statement on forms PTO/SB/08A and/or PTO/SB/08B and a copy of the art cited thereon. Applicants respectfully request that the Examiner consider carefully the complete text of the cited reference(s) in connection with the continued examination of the above-identified application in accord with 37 CFR §1.104(a). It is respectfully requested that all cited reference(s) considered by the Examiner be listed in the "References Cited" section of any patent issuing from the present application.

Conclusion

In view of the above amendments and remarks, Applicants believe that the rejections of claims 1 to 25, 52, and 53 are overcome. Applicants request reconsideration of claims 8, 10-25, 52, and 53.

Respectfully submitted,

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